

REMARKS

Claims 1-35 are pending in the application.

Claims 1-15 have been rejected.

Claims 16-35 have been withdrawn.

Claims 10, 12 and 13 have been canceled, without prejudice.

Claims 1-9, 11, 14 and 15 have been amended, as set forth herein.

New Claims 36-42 have been added.

I. ELECTION/RESTRICTION

In accordance with the Office Action, Applicant hereby confirms the provisional election of Claims 1-15, with traverse, in response to the restriction requirement.

II. CORRECTION TO FIGURE 5

Applicant is submitting concurrently herewith a Proposed Drawing Amendment to correct an inadvertent error in Figure 5. The noted error is that reference numeral "28" should be "20". The Applicant is submitting this correction to Figure 5 as a Proposed Drawing Amendment because the Applicant is unsure whether the original drawings as submitted were approved by the Office (the outstanding Office Action does not indicate whether the drawings are accepted or objected to).

III. REJECTION UNDER 35 U.S.C. § 112

Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Applicant has amended Claims 1-9, 11 and 13-15 to correct noted informalities and inconsistencies. Claims 10, 12 and 13 have been canceled.

Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection of Claims 1-9, 11, 14 and 15.

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2 and 10-14 were rejected under 35 U.S.C. § 102(e) as being anticipated by Willis (US 5,433,742). Claims 1-3 and 10-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Champeau (US 6,208,881). The rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Willis fails to disclose at least one conductor embedded within the wall of the body member and extending the length of the body member. See, Claim 1, as amended. Willis houses the conductors or wires 50 within a lumen 48. See, Willis, Col. 4, lines 37-40; Figure 3. As a result, Willis fails to anticipate Applicant's claimed invention.

Champeau fails to disclose an electroplated conductive link extending through a tunnel from the conductor to the electrode. See, Claim 1, as amended; Champeau, Col. 7, lines 15-40. Therefore, Champeau fails to anticipate Applicant's claimed invention.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejections of Claims 1-3 and 10-15.

V. REJECTION UNDER 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Gotthardt (US 5,016,646) in view of Willis (US 5,433,742). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of

nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Gotthardt and Willis do not disclose, teach or suggest, either alone or in combination, Applicant's electroplated conductive link connecting the conductor to the electrode. See, Gotthardt, Col. 5, lines 34-46; Willis, Col 5, line 48 thru Col. 6. line 12.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 1-14.

VI. NEW CLAIMS 37-42

Applicant has added new Claims 37-42 and respectfully submits that the new claims are patentable over the cited art of record for at least the reasons set forth above.

VII. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 4/7/2003



Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*